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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,519	02/28/2005	Kyoko Yokoi	TIP-05-1007	1423
35811 7590 01/06/2010 IP GROUP OF DLA PIPER LLP (US) ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103				
			EXAMINER	
			CHIRISS, JENNIFER A	
		ART UNIT	PAPER NUMBER	
		1794		
		NOTIFICATION DATE	DELIVERY MODE	
		01/06/2010 ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

### Office Action Summary

**Application No.**

10/522,519

**Applicant(s)**

YOKOI ET AL.

**Examiner**

JENNIFER A. CHRISS

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Amendments and Accompanying Remarks filed on November 13, 2009 has been entered and carefully considered. Claims 5 and 7 are amended and claims 5 – 8 are pending. In view of Applicant's amendment to claims 5 and 7 requiring that the pigments are impregnated into the ultra-fine polyester fibers within the fiber-entangled substrate, the Examiner withdraws all previously set forth rejections. However, after an updated search, additional art has been found which renders the invention as currently claimed unpatentable for reasons herein below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a. The Specification fails to provide proper antecedent basis for the new limitation of claim 5 requiring that the pigments are "impregnated into the ultra-fine polyester fibers within the fiber-entangled substrate" and the new limitation of claim 7 requiring "impregnating into the ultra-fine polyester fibers within the fiber-entangled substrate".

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5 – 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Claims 5 and 7 recite the new limitations of the pigments are "*impregnated into the ultra-fine polyester fibers* within the fiber-entangled substrate" and "*impregnating into the ultra-fine polyester fibers* within the fiber-entangled substrate", respectively.

Throughout the Specification, Applicant has support for impregnating the pigments into the fiber-entangled substrate made of ultra-fine polyester fibers but not actually impregnating the fibers themselves. The Examiner will interpret the claims as requiring that the fiber-entangled substrate is impregnated and not the actual fibers as the

Examiner believes this was an inadvertent error. However, the Applicant is required to amend the claims to meet the written description requirement.

***Claim Rejections - 35 USC § 103***

7. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the full English translation of Shioda et al. (JP 05-321159) in view of Streicher et al. (US 4,983,185).

Shioda et al. is directed to a colored suede-tone synthetic leather which has excellent durability to light and resistance to discoloration and fading (page 2, [0001]).

As to claims 1 and 7, Shioda et al. teach impregnating a fluffed polyester fiber substrate made of ultra-fine synthetic fibers with colored polyurethane (pages 2 - 3, [0002]). Shioda et al. teach using a black pigment to color the polyurethane (pages 4 - 5, [0010 - 0014]) but note that the pigment can be used as a main coloring material or a hue correction coloring material and can be used along with other coloring materials (pages 5 and 6, [0012 - 0015]). Shioda et al. teach that the ultra-fine fiber can have a denier of 0.5 or 0.56 dtex (page 8, [0022]).

Shioda et al. teach the claimed invention above but fails to specifically teach that the polyurethane contains at least one each of yellow, red and blue pigments selected from the group consisting of diketopyrrolopyrrole, anthraquinone, perylene, perynone, quinacridone, azo, polyazo, condensed azo, imidazolone, phthalocyanine, isoindoline, indigo, thioindigo, azomethine, azomethine-azo, dioxazine, indanthrone, flavanthrone

and pyranthrone.

Streicher et al. is directed to dyeing of leather with pigments (Title). Streicher et al. note that the pigments create a leather with good lightfastness (column 1, lines 10 – 20). Streicher et al. teach that the leather can be treated with individual pigments but also with mixtures of pigments. Preferably, the leather is dyed with a mixture of yellow, red and blue pigments, which gives rise to brown shades (column 5, lines 64 - 69). Streicher et al. note that the process makes it possible to obtain leather which has excellent levelness, depth of shade, brilliance and high lightfastness, wetfastness and migration fastness properties (column 6, lines 1 - 5). Streicher et al. note that the pigments may be selected from various pigments such as mono-azo pigments, anthraquinone pigments, thioindigo pigments, azomethine-azo pigments, quinacridone pigments and dioxazine pigments (column 2, lines 60 - 69 and column 3, lines 1 - 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include yellow, red and blue pigments selected from mono-azo pigments, anthraquinone pigments, thioindigo pigments, azomethine-azo pigments, quinacridone pigments and dioxazine pigments motivated by the desire to create a suede sheet material having a natural brown color while exhibiting excellent durability to light and resistance to discoloration and fading.

Shioda et al. in view of Streicher et al. teach the claimed invention above but fails to teach that the infrared reflectance is 850 nm at 60% or more, the surface temperature during light irradiation is 105 C or lower, light fastness is class 3 or better, the

discoloration ratio after reduction cleaning is 20% or less and the chroma is 10 or less. It is reasonable to presume that the above discussed properties are inherent to Shioda et al. in view of Streicher et al. Support for said presumption is found in the use of like materials (i.e. an artificial leather containing fibers of a similar linear density range impregnated with a polyurethane binder which is colored with red, blue and yellow pigments selected from the pigments of claims 5 and 7) which would result in the claimed properties. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed properties would obviously have been present once the Shioda et al. in view of Streicher et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

8. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shioda et al. (JP 05-321159) in view of Streicher et al. (US 4,983,185) as applied above, and further in view of Pedain et al. (US 3,867,350).

Shioda et al. in view of Streicher et al. teach the claimed invention above but is silent to the use of a polycarbonate-based polyurethane.

Pedain et al. relates to polyurethane urea elastomers based on polycarbonate macrodiols which have the advantage of being less of a physiological hazard, that are more resistant to common solvents and require less emulsifiers and dispersion aids (Title and Abstract). The reference teaches the use of the resin for the production of coatings applied to substrates such as leather and artificial leather (column 6, lines 20-31).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the resin of Shioda et al. in view of Streicher et al. and provide it with the polycarbonate based polyurethane of Pedain et al. with the motivation of using an elastomer that is less of a physiological hazard, that is more resistant to common solvents and require less emulsifiers and dispersion aid as disclosed by Pedain et al. (Abstract).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 5 – 8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. CHRISS whose telephone number is (571)272-7783. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 6 p.m., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer A Chriss/  
Primary Examiner, Art Unit 1794

/J. A. C./  
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